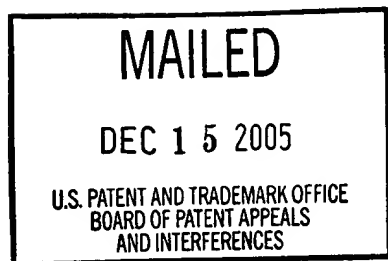


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte PAUL C. ZIMMER

Appeal No. 2005-2375
Application No. 09/612,821

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing¹ of our decision mailed October 25, 2005, wherein we affirmed the examiner's rejection of claims 1 to 5 under 35 U.S.C. § 103.²

¹ Filed November 25, 2005.

² The Notice of Abandonment, mailed November 2, 2005, is obviously premature since the appellant has two months from the date of our decision to seek rehearing (i.e., reconsideration). 37 CFR 41.52.

One issue (pp. 3-4) raised by the appellant is that a functional relationship exists between the calendar and the imprint of a person's name and should be given patentable weight. We have carefully considered the arguments presented by the appellant in support of this issue but those arguments do not persuade us that our decision was in error in any respect. It remains our view (decision, pp. 4-5) that (1) the only differences between the instant invention and the Hallam calendar is the content of the printed matter placed on each page of the calendar; and (2) there does not exist any new and unobvious functional relationship between the printed matter and the substrate.³

Another issue (pp. 1-3) raised by the appellant is that in view of the different basis for the affirmance of the rejection than that put forth by the examiner the appellant requests that he be allowed to withdraw the grouping of claims 1 to 5 together and that the Board specifically consider claims 4 and 5 on their merits.

We have reviewed claims 4 and 5 on their merits and see no reason why they would be patentable over the Hallam calendar. Once again, the only differences between the instant invention as set forth in claims 4 and 5 and the Hallam calendar is the content of the printed matter placed on each page of the calendar and there does not exist any

³ Our reviewing court has stated that where the differences between the claimed invention and the prior art resides in printed matter, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); In re Gulack, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983)

and unobvious functional relationship between the printed matter and the substrate.

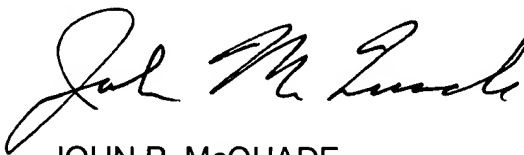
Accordingly, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 was correct.


In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change in our decision to affirm the rejection of claims 1 to 5 under 35 U.S.C. § 103.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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